



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/291,894	04/13/1999	PETER L. COLLINS	17634-000520	2725
------------	------------	------------------	--------------	------

20350 7590 12/20/2001

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

BRUMBACK, BRENDA G

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 12/20/2001

15

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/291,894

**Applicant(s)**

COLLINS ET AL.

**Examiner**

Brenda G. Brumback

**Art Unit**

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 16, 18-21, 35, 46-59, 64 and 65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 16, 18-21, 35, 46-59, 64 and 65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1642

### **DETAILED ACTION**

1. This action is responsive to the amendment filed 09/21/2001. Claim 35 was amended. Claims 1-35 and 46-65 are pending. Claims 1-12, 16, 18-21, 35, 46-59, and 64-65 are examined on the merits.

2. This application contains claims 13-15, 17, 22-34, and 60-63 drawn to an invention nonelected in Paper No. 11. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### ***Drawings***

3. The corrected drawings was received on 09/21/2001. This drawing is approved.

#### ***Claim Objections***

4. The objection to claim 35 under 37 CFR 1.75© is withdrawn pursuant to applicant's amendment thereof.

#### ***Claim Rejections - 35 USC § 112***

5. The rejection of claims 5, 7, and 8-10 under 35 U.S.C. 112, second paragraph, is withdrawn. Applicant's arguments were persuasive.

Art Unit: 1642

The rejection of claims 5, 7, and 8-10 under 35 U.S.C. 112, first paragraph, is withdrawn. Applicant's arguments and evidence were persuasive.

***Double Patenting***

6. The provisional rejection of claims 1-12, 16, 18-21, 35, 46-59, and 64-65 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 96-103, 131, and 151-153 of copending Application No. 09/444,067 and claims 20, 31, and 56 of copending Application No. 09/444,221 is maintained. Applicant's deferral of addressing the merits of the rejection until the claims in one of the subject cases are patented is noted.

***Claim Rejections - 35 USC § 102/103***

7. The rejection of claims 1-12, 16, 18-21, 35, 46-59, and 64-65 under 102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Randolph et al. is withdrawn. Applicant's arguments were persuasive.

8. The rejection of claims 1-12, 16, 18-21, 35, 46-59, and 64-65 under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. in view of Collins et al. is maintained. Applicant's amendment to claim priority to the later filed application serial number 09/847,173; which claims priority to U.S. Patent Application Number 08/720,132; which in turn claims priority to U.S.

Art Unit: 1642

Provisional Application No. 60/007,083, filed September 27, 1995; is noted; however, applicant cannot overcome the present rejection by claiming priority to an application which has a later filing date than that of the present application.

***NEW GROUNDS OF REJECTION***

***Oath/Declaration***

9. Applicant is advised that if the present application were amended to claim priority as a continuation-in-part of U.S. Patent Application No. 08/720,132, a new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date would be required (see MPEP §§ 602.01 and 602.02). Upon such an amendment, the present oath or declaration would be defective because it does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

***Specification***

10. The amendment filed 09/21/2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall

Art Unit: 1642

introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is the incorporation by reference of U.S. Patent Application Numbers 09/847, 173; 08/720,132; and 60/007,083.

Applicant is required to cancel the new matter in the reply to this Office action.

***Conclusion***

11. No claims are allowed.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1642

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Brumback whose telephone number is (703) 306-3220. If the examiner can not be reached, inquiries can be directed to Supervisory Patent Examiner Anthony Caputa whose telephone number is (703) 308-3995. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Examiner Brenda Brumback, Art Unit 1642 and should be marked "OFFICIAL" for entry into prosecution history or "DRAFT" for consideration by the examiner without entry. The Art Unit 1642 FAX telephone number is (703)-305-3014. FAX machines will be available to receive transmissions 24 hours a day. In compliance with 1096 OG 30, the filing date accorded to each OFFICIAL fax transmission will be determined by the FAX machine's stamped date found on the last page of the transmission, unless that date is a Saturday, Sunday or Federal Holiday with the District of Columbia, in which case the OFFICIAL date of receipt will be the next business day.

BB

December 20, 2001

  
Brenda Brumback,  
Patent Examiner